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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BOTTS, MICHAEL K

ART UNIT PAPER NUMBER

2176

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,516	Applicant(s) JONES ET AL.	
	Examiner Michael K. Botts	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/9/03; 9/7/04; 11/8/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on December 9, 2003 as a continuation in part of Non-Provisional Application 10/187,060, which was filed on June 28, 2002, and an Information Disclosure Statement (IDS), which was filed on September 7, 2004, and a Preliminary Amendment, which was filed on November 8, 2004.
2. Claims 1-22 have been examined, with claims 1, 11, and 16 being the independent claims.
3. The Drawings are objected to.
4. The Abstract is objected to.
5. The Specification is objected to.
6. Claims 1-22 are rejected.

Information Disclosure Statement

7. An initialed and dated copy of applicant's IDS form 1449, which was filed on September 7, 2004, is attached to this Office Action.

Drawings

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 400, and 500. Corrected drawing sheets in compliance with 37 CFR

1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract of the Disclosure

9. The abstract of the disclosure is objected to because of the use it does not accurately reflect the invention claimed. The statement that the invention "may be manipulated on a server or anywhere even when the application creating the ML document is not present" is not claimed, and is essentially inherent in the markup language itself. In addition, the statement that the invention lists "may be manipulated when the ML document is parsed by other applications," similarly identifies a property of a markup language, rather than that of the invention itself. Finally, the statement that "List definition information (i.e. properties) are save in a markup language (ML) document without data loss, while allowing the lists to be parsed by ML-aware applications and to be read by ML programmers" also merely states inherent properties

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of the markup language, rather than stating a concise description of the invention.

Correction is required. See MPEP § 608.01(b).

10. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

11. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Specification

12. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.

13. This application contains a computer program listing of more than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing contained on more than three hundred (300) lines, must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(b)(5)). Accordingly, applicant is required to cancel the current computer program listing, file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c), and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

14. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Case Western Reserve University (CRWU), "Introduction to HTML," Case Western Reserve University and Eric A Meyer, March 4, 2000, last downloaded by the Examiner on December 21, 2005, from:
web.archive.org/web/20000304042655/http://www.cwru.edu/help/introHTML/toc.html, downloaded pages 1-157, [hereinafter "CRWU"].

Regarding **independent claim 1**, CWRU teaches:

A method for representing list information in a markup language document, comprising:
determining properties corresponding to a list that relates to at least one section of an application document;
mapping the properties of the list into at least one of a markup language element, an attribute, and a value; and
storing the properties of the list in the markup language document.

(See, CWRU, downloaded pages 1-2 and 5-6, teaching a list with properties and attributes relating to at least one section of the document that are mapped to a markup language and that were inherently stored, because they were downloaded by the Examiner from web.archive.org, as identified above.)

Regarding **dependent claim 2**, CWRU teaches:

The method of Claim 1, further comprising determining whether the list is a picture bulleted list.

(See, CWRU, downloaded pages 74-82 teaching picture bulleted lists.)

Regarding **dependent claim 3**, CWRU teaches:

The method of Claim 2, wherein a specified element and attribute are included to store the picture bullet image information and picture bullet identifier when the list is a picture bullet list.

(See, CWRU, downloaded pages 1-2, 5-6, and 74-82, teaching various bulleted lists, with those taught on pages 74-82 being picture bullet images and having elements but no attributes, and those on pages 1-2 and 5-6 teaching elements and attributes, but with standard bullets. It is inherent from the teachings of CWRU that the picture bullet images from pages 74-82 could have been used on pages 1-2 and 5-6.)

Regarding **dependent claim 4**, CWRU teaches:

The method of Claim 1, further comprising determining whether the list is a new list within the application document, wherein the list is a new list when the application document includes a previously presented list within the document.

(See, CWRU, downloaded pages 61-62 and 68-70, teaching new list material to days of the week list.)

Regarding **dependent claim 5**, CWRU teaches:

The method of Claim 4, further comprising providing a list override such that the instances and definitions of the new list and the previously presented list are separated when stored in the ML file.

(See, CWRU, downloaded pages 61-82 teaching the creation of various list types and the separate storing of those lists. It is inherent in the teachings of CWRU that the various lists may be edited to add new lists and may be stored separately.)

Regarding **dependent claim 6**, CWRU teaches:

The method of Claim 1, wherein mapping the properties further comprises mapping a level tag that corresponds to the level of an item within a list.

(See, CWRU, downloaded pages 62-64 and 68-71, teaching levels of items within a list.)

Regarding **dependent claim 7**, CWRU teaches:

The method of Claim 6, wherein the level tag allows the list to define the indentation of a level and the character used to represent the level.

(See, CWRU, downloaded pages 61-82 teaching setting level indentation.)

Regarding **dependent claim 8**, CWRU teaches:

*The method of Claim 1, further comprising:
determining properties corresponding to an additional list that relates to at least one section of the application document;
mapping the properties of the additional list into at least one of a markup language element, an attribute, and a value;
including a list override to separate the instance of the list and the additional list; and
storing the properties of the additional list in the markup language document.*

(See, CWRU, downloaded pages 1-2 and 5-6 teaching separate lists with elements and attributes stored.)

Regarding **dependent claim 9**, CWRU teaches:

The method of Claim 1, wherein the properties of the list stored in the markup language document are understood by an application that understands the markup language when the list is not native to the application.

(It is noted that the term “native” is not explicitly defined in the application. It is believed that the applicants intended the term “native” in this claim to be used as it was understood by one of ordinary skill in the art at the time of the invention. For reference, see, Microsoft Computer Dictionary, Fifth Edition, 2002, definition of “native file format,” which states: “The format an application uses internally to process data. The application must convert files in other formats to the native format before it can work with them. For example, a word processor might recognize text files in ASCII text format, but it will convert them to its own native format before it displays them.”

See, CWRU, downloaded page 27, teaching writing the data, inherently including lists, in ASCII, saving it, and opening it in another program, such as one of many Web browser programs.)

Regarding **dependent claim 10**, CWRU teaches:

The method of Claim 1, wherein the markup language document is manipulated on a server to substantially reproduce the list of the application document notwithstanding the presence of an application that generated the markup language document.

(See, CWRU, downloaded page 27, teaching saving the file to a Web server.)

Regarding **independent claim 11**, CWRU teaches:

A computer-readable medium for representing list definitions and instances in a markup language document, comprising:

determining properties relating to a list used within a word-processing document;

determining whether the list is a new list that follows a previously determined list;

including a list override when the list is a new list such that the instance of the list is separated from the instance of the previously determined list;

writing the properties into at least one of a markup language element, an attribute, and a value; and

storing the properties in the markup language document such that the list is substantially maintained when the markup language document is parsed by an application.

(See, CWRU, downloaded pages 1-2 and 5-6, teaching a list with properties and attributes relating to at least one section of the document that are mapped to a markup language and that were inherently stored, because they were downloaded by the Examiner from web.archive.org, as identified above.

See also, CWRU, downloaded pages 61-62 and 68-70, teaching new list material to days of the week list.

See also, CWRU, downloaded pages 61-82 teaching the creation of various list types and the separate storing of those lists. It is inherent in the teachings of CWRU that the various lists may be edited to add new lists and may be stored separately.)

Regarding **dependent claim 12**, claim 12 is rejected on the grounds used in rejection of claim 11 above, and claim 12 additionally incorporates substantially similar subject matter as that claimed claim 9 above, and is additionally rejected along the same rationale as used in the rejection of claim 9.

Regarding **dependent claim 13**, claim 13 is rejected on the grounds used in rejection of claim 11 above, and claim 13 additionally incorporates substantially similar subject matter as that claimed claim 10 above, and is additionally rejected along the same rationale as used in the rejection of claim 10.

Regarding **dependent claim 14**, claim 14 is rejected on the grounds used in rejection of claim 11 above, and claim 14 additionally incorporates substantially similar subject matter as that claimed claim 2 above, and is additionally rejected along the same rationale as used in the rejection of claim 2.

Regarding **dependent claim 15**, claim 15 is rejected on the grounds used in rejection of claim 11 above, and claim 15 additionally incorporates substantially similar subject matter as that claimed claim 3 above, and is additionally rejected along the same rationale as used in the rejection of claim 3.

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to

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be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over CWRU as applied to claims 1-15 above, and further in view of Lemay, Laura, "Teach Yourself Web Publishing with HTML 4 in 14 Days, Professional Reference Edition," Second Edition, Sams.net Publishing, 1997, pages 778-789, [hereinafter "Lemay"].

Regarding **independent claim 16**, CWRU in view of Lemay teaches:

A system for representing list definitions and instances in a markup language document, comprising:

an application that is configured to:

determine properties relating to a list included in at least one section of an application document;

*map the properties into at least one of a markup language element,
an attribute, and a value; and*

*store the properties in the markup language document; and a
validation engine configured to validate the markup language document.*

(See, CWRU, downloaded pages 1-2 and 5-6, teaching a list with properties and attributes relating to at least one section of the document that are mapped to a markup language and that were inherently stored, because they were downloaded by the Examiner from web.archive.org, as identified above.

See also, CWRU, downloaded pages 61-62 and 68-70, teaching new list material to days of the week list.

See also, CWRU, downloaded pages 61-82 teaching the creation of various list types and the separate storing of those lists. It is inherent in the teachings of CWRU that the various lists may be edited to add new lists and may be stored separately.

CWRU does not explicitly teach a validation engine configured to validate the markup language document.

Lemay teaches the use of a validation engine to validate markup language code. CWRU and Lemay are analogous because they are from the same field of endeavor of instructive texts in the creation and manipulation of markup language code. It would have been obvious to one of ordinary skill in the art ^{at the time of the invention} to validate a markup language document with a validation engine. The suggestion or motivation for combining markup language code with a validation engine is implicitly stated in CWRU. See, CWRU, downloaded page 27, second full paragraph, teaching testing the code. The suggestion

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or motivation for combining markup language code with a validation engine is explicitly stated in Lemay. See Lemay, pages 778-789.)

Regarding **claims 17-22**, claims 17-22 are rejected on the grounds used in rejection of claim 16 above, and claims 17-22 additionally incorporate substantially similar subject matter as that claimed claims 12-15, 4, and 5 above, respectively, and are additionally rejected along the same rationale as used in the rejections of claims 12-15, 4, and 5.

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Conclusion

17. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

White, B. and McDunn, R., "Standard Structural Elements," from "Web Content Accessibility Tips and Tricks," May 1, 2001, last downloaded by the Examiner on December 21, 2005 from: www-group.slac.stanford.edu/wim/accessibility/structure.html, downloaded pages 1-4.

Juran, J., "MML: The Modest Markup Language," October 22, 2000, last downloaded by the Examiner on December 21, 2005, from:

web.archive.org/web/20001022231038/http://www.metamage.com/proj/mml/html,
downloaded pages 1-15.

University of Georgia Center for Continuing Education, "Exploring the World-Wide Web, Hypertext Markup Language," February 24, 1999, last downloaded by the Examiner on December 21, 2005, from www.georgiacenter.uga.edu/exploring/html.html, downloaded pages 1-7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
12/22/2005